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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,206	11/12/2003	Robert Francis de Sylva		8268

7590 06/27/2007  
Robert de Sylva  
161 Ocean Park Blvd. #D  
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EXAMINER
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PAIK, STEVE S.

ART UNIT	PAPER NUMBER
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2876

MAIL DATE	DELIVERY MODE
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06/27/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/712,206

Applicant(s)

DE SYLVA, ROBERT FRANCIS

Examiner

Steven S. Paik

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) 25-44 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Response to Amendment*

1. Receipt is acknowledged of the Amendment filed April 10, 2007. The applicant amended claims 15, 16, and 23.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-11 and 15-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Mitchell et al. (US 2003/0149661 A1).

Re claim 1, Mitchell et al. disclose a payment management system (100) comprising:  
a charging terminal (EFTPOS terminal in [0002]) for charging an account based on an account number (credit card /debit card number);  
a scanner (fingerprint reader in Fig. 1) for obtaining biometric information (fingerprint);  
and  
first means (POS/ATM in [0023]) for employing said biometric information to automatically provide an account number to said charging terminal ([0007]-[0008] and [0023]-[0024]).

Re claim 2, Mitchell et al. disclose the system as recited in rejected claim 1 stated above, wherein said first means is a credit card or Automated Teller Machine (ATM) terminal, and

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wherein said account number includes a credit number and a corresponding expiration date or an ATM number and a corresponding personal identification number ([0023]-[0024]).

Re claim 3, Mitchell et al. disclose the system as recited in rejected claim 1 stated above, wherein said first means includes means for automatically selecting based on said biometric information an account from among plural accounts based on said biometric information ([0017]-[0018] and [0049]).

Re claim 4, Mitchell et al. disclose the system as recited in rejected claim 3 stated above, further including second means (the fingerprint reader has controls; [0049]) for enabling a user to control which account number is selected by said first means (MasterCard/Visa/Diner's club, etc.).

Re claim 5, Mitchell et al. disclose the system as recited in rejected claim 4 stated above, wherein said second means includes third means (arrow keys) for enabling a user to prioritize plural accounts, an available account with the highest priority ([0050]) being automatically selected by said first means (The user or merchant could prioritize these account according to some scheme; [0050]-[0051]).

Re claim 6, Mitchell et al. disclose the system as recited in rejected claim 4 stated above, wherein said second means includes software that enables (320 in Fig. 3) a user to trigger automatic selection of an account based on which type of biometric information or combination of biometric information that said user provides ([0049]).

Re claim 7, Mitchell et al. disclose the system as recited in rejected claim 4 stated above, wherein said system further includes fourth means for providing transaction information, including amount of said transaction and/or type of said transaction, to said first means ([0052]).

Re claim 8, Mitchell et al. disclose the system as recited in rejected claim 7 stated above, wherein said second means includes fifth means ([0053]- [0056]) for enabling a user to specify selection rules or selection criteria based on said transaction information that dictate which account is selected by said first means based on said transaction information.

Re claim 9, Mitchell et al. disclose the system as recited in rejected claim 7 stated above, wherein said first means includes sixth means (POS terminal will have a card reader to read the magnetic strip on a credit or debit card, and this information on the customer's account will be linked to a keypad, on an EFTPOS remote terminal enabling the customer to enter a PIN f required, and in the case of credit card transaction to push the button marked "credit" so that the information from the card and the customer's PIN (if required) is transmitted to a clearing house.) for employing transaction type information to limit selection of account numbers to only those account numbers that are associated with accounts that are compatible with said transaction type ([0048]-[0049]).

Re claim 10, Mitchell et al. disclose the system as recited in rejected claim 4 stated above, wherein said first means includes a database ([0018]) that is remotely accessible to a user, said database including means for authenticating said user before allowing said user to alter selection rules associated with accounts of said user ([00619]-[0021]).

Re claim 11, Mitchell et al. disclose the system as recited in rejected claim 1 stated above, wherein system further includes seventh means (clearing house; ([0051]-[0052]) for automatically providing transaction information to said charging terminal.

Re claim 15, Mitchell et al. disclose a payment management system (Fig. 1) comprising:

first means (fingerprint reader) for measuring one or more biological characteristics of a user;

second means (controls along with arrow keys) for automatically selecting an account from plural accounts associated with a user based on said one or more biological characteristics and providing a transaction signal in response thereto; and

third means ([0052]) for implementing a funds transfer to or from said selected account in accordance with said financial transaction in response to said transaction signal (Fig. 2).

Re claim 16, Mitchell et al. disclose the system as recited in rejected claim 15 stated above, wherein said first means includes means for providing a first signal (good scan) based on said one or more biological characteristics, said first signal acting as an authorization signal, an authentication signal, and an account-selection signal, said second means providing said transaction signal based on said first signal (acceptance) and wherein said second means (controls along with arrow keys) does not require participation of a clearing house.

Re claim 17, Mitchell et al. disclose the system as recited in rejected claim 16 stated above, wherein said second means further includes a database ([0017]-[0018]) for selectively outputting account information contained in said transaction signal based on said first signal.

Re claim 18, Mitchell et al. disclose the system as recited in rejected claim 17 stated above, wherein said database includes an account list, said account list being user-configurable, thereby enabling a user to selectively control which account is automatically selected by said second means in response to said first signal (good scan; [0024]-[0025]).

Re claim 19, Mitchell et al. disclose the system as recited in rejected claim 18 stated above, further including means for identifying a user (biometric reader and card/check reader;

{0033}) before enabling said user to access or configure information that is stored via said database and that is associated with said user.

Re claim 20, Mitchell et al. disclose the system as recited in rejected claim 17 stated above, further including means for enabling a user to predetermine account selection rules for accounts listed in said database, said selection rules determining which account is selected in response to a charge initiated by said system ([0055]).

Re claim 21, Mitchell et al. disclose the system as recited in rejected claim 20 stated above, wherein said means for enabling includes a terminal (EFTPOS Remote in Fig. 1) positioned remotely from a point-of-sale associated with said financial transaction.

Re claim 22, Mitchell et al. disclose the system as recited in rejected claim 19 stated above, further including means for employing said first signal to authenticate (Credit database matching process and a resulting signal from that process) said user before providing said transaction signal to said third means ([0052]).

Re claim 23, Mitchell et al. disclose the system as recited in rejected claim 22 stated above, wherein said second means includes means for storing information pertaining to said one or more biological characteristics of a user when said means for employing fails to authenticate said user ([0051])

Re claim 24, Mitchell et al. disclose the system as recited in rejected claim 15 stated above, wherein said third means ([0052]) includes a credit card, charge card, and/or Automated Teller Machine (ATM) charging module, and wherein said transaction signal includes a selected credit card, charge card, or ATM card number associated with said user and any relevant pins or dates ([0052]).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 12-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitchell et al. (US 2003/0149661 A1) in view of Kipp (US 5,239,167).

Re claims 12-14, the teachings of Mitchell et al. have been fully discussed with the exception of means for wirelessly interrogating product tags associated with products to be purchased, price information and deactivation process.

Kipp discloses a checkout system that uses radio frequency tags. An article 12 is associated with a respective transmitter means 20 for transmitting product-identifying data upon actuation and then deactuating itself. The transmitter 20 may be in the form of a tag associated with the article and securely attached thereto to prevent accidental separation. Examples of product-identifying data may be a product price, volume or weight of the product. Once the tag successfully transmits all of the product identifying data (26), it reads an erase signal which causes deactuation of the signal trigger (24) so that the transmitter is inactivated. Once the transmitter of this article turns itself off, the remaining articles 12 in a container 10 will be read in turn in a sequence determined by the receipt by the receiver in the checkout area 14. The system allows a faster and accurate retail transactions with a minimum supervision of a store clerk or a manager.



In view of Kipp's teaching, it would have been obvious to an artisan of ordinary skill in the art at the time the invention was made to further employ a checkout system for conducting an operator-unassisted checkout in addition to the payment management system of Mitchell et al. for the purposes of minimizing manpower in a retail environment while increasing checkout speed without compromising the accuracy of the retail transactions.

***Response to Arguments***

6. Applicant's arguments filed April 10, 2007 have been fully considered but they are not persuasive.

**Rejections under 35 U.S.C. §102 (e)**

The applicant argues that Mitchell does not teach, disclose, or suggests a mechanism for employing biometric information to automatically provide an account number to a charging terminal. The system of Mitchell does not teach retrieval of an account number to a charging terminal and certainly does not teach automatic retrieval of an account number to a charging terminal. Instead, Mitchell teaches sending a biological identifier, such as a fingerprint, to a clearing house for processing (pages 7-9 of the Amendment).

The examiner respectfully disagrees. The Mitchell reference discloses the following:

The solution involves the use of a unique biological identifier, together with an appropriate measuring device at the remote terminal, which allows the user to do away completely with the plastic card if the user so desires. The invention allows the user to rely completely on the **unique biological identifier to serve both as the account number and/or the PIN**, or allows the user to combine the use of this unique biological identifier with a plastic card and/or separate PIN. The invention will be more readily understood by reading the description of the preferred embodiments. For the moment the invention will be considered in general terms ([0007]).

The above discloses that the biometric information is used to provide account number to a charging terminal. Therefore, the applicant's argument is not persuasive.

The applicant further argues that Mitchell apparently involves manual user manipulation of "controls" to select an account via an EFTPOS [0049], wherein the account is associated with a biological identifier. This in no way teaches, discloses, or suggests automatic selection of an account from among plural accounts based on biometric data.

The examiner disagrees. Mitchell further teaches that Indeed it is possible by using fingerprints to use the prints on different fingers to access different accounts at the same bank, or to access different accounts at other banks or credit card companies. Therefore, the reference discloses different ways to access one financial account from a plurality of financial accounts.

Each of the claims rejected under 35 U.S.C. § 102(e) is fully discussed with examiner's interpretation.

**Rejections under 35 U.S.C. §103 (a)**

The applicant argument starting on page 24 shows that the combination of Kipp and Mitchell would show at most a system for using a biological identifier as a credit card number via a terminal that requires navigation of a user interface ([0049]-[0050]), to pay a total determined by Kipp. Such a combination would not teach disclose or suggest the invention as claimed and would lack various benefits, including anti-theft provisions, automatic checkout, and so on.

7. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5

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USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the combination would obviously allow minimizing manpower in a retail environment while increasing checkout speed without compromising the accuracy of the retail transactions.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (shown on pages 24-33 of the remarks) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In view of above discussion, claims 1-24 remain rejected under 35 U.S.C. § 102(e) or 103(a).

### ***Conclusion***


8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven S. Paik whose telephone number is 571-272-2404. The examiner can normally be reached on Monday - Friday 6:30a-3:00p (Maxi-Flex\*).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
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ssp